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EXAMINER

GOODWIN, JEANNE M

ART UNIT PAPER NUMBER

2841

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/876,759

Applicant(s)

PATELLA, NICHOLAS P.

Examiner

Jeanne-Marguerite Goodwin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10, 16, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3: the phrase "such as" renders the claim indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See *Ex parte Steigewald*, 131 USPQ 74.

Claims 2-10, 16, 18 and 19 rejected to as being dependent upon a rejected claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by over US Patent 6,411,570 to Smith [hereinafter Smith].

Smith discloses a device for conditioning subjects, especially children, to perform

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specific tasks having an elliptical shell comprising fastening device (22) for the device to be fastened to a waist belt, hung around the neck, upper arm, or shoulder, carried in a pocket, or carried in any other fashion so as to be near enough to be heard, a microprocessor/chip 21, inherently, having a signal circuit for producing a signal, a speaker (24) to relay any message and/or alarm sound produced by the device, a time display (14), a timer means/stop-watch controller (11) connected to the microprocessor (21) for setting a time interval and activating the signal circuit at the end of the time interval to alert the child to another activity, the microprocessor/signal circuit assembly includes three alarms (17, 18 and 19) of which the three alarms will merely be two repeats of a first alarm/message so as to be sure that the first alarm/message is obeyed. Accordingly, by pushing the alarm (17) it would automatically initiate the second and third time intervals of alarms (18 and 19). Furthermore, the microprocessor/timer assembly can be prepared to accommodate any given set of times, e.g., normal and short, dates and activities.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 2, 3, 8, 9, 11, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of US Patent 4,725,999 to Tate [hereinafter Tate], US Patent 4,624,578 to Green [hereinafter Green] and US 6,198,965 to Kirton et al. [hereinafter Kirton].

Smith discloses a device as stated above with regards to claims 1, 4 and 5. Smith

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discloses all the subject matter claimed by applicant with the exception of the limitations stated in claims 2 and 11, i.e., an accomplishment switch operable with the timer means upon actuation to interrupt and reset the timer means to another time interval; the limitation stated in claims 3 and 11, i.e., visual means displaying timer intervals; the limitation stated in claims 8 and 10, i.e., graphic means displayed on the visual means; the limitation stated in claims 9 and 10, i.e., a pause means; and the limitations stated in claim 16, i.e., a number of normal time intervals is set by comparing the first and subsequent manual operations of the accomplishment switch correlated to a 24 hour period and establishing the new normal time interval ending at the times of peak probability of signal activation.

With respect to the limitations stated in claims 2 and 11: Tate discloses a device for conditioning subjects to take medications at different intervals of time comprising a reset switch which is pressed in order to stop an alarm and for a next time interval to begin. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the reset switch, as taught by Tate, to the timer, as taught by Smith, in order to stop an alarm and for a next time interval to begin.

With respect to the limitation stated in claims 3 and 11: Green discloses a timer system comprising a display (22) which displays an interval time and a display (24) which displays the current time in order to be able to display the interval time and the current time at the same time. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the display (22), as taught by Green, to the device, as taught by Smith, in order to be able to display the interval time and the current time at the same time.

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With respect to the limitation stated in claims 8 and 10: Official Notice is taken with respect to the visual means displaying, i.e., graphics, since it is well known in the timepiece art to display various amount of information as an indication to a user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add graphic means as claimed by applicant, to the display of Smith, in order make the displayed information aesthetically pleasing.

With respect to the limitation stated in claims 9 and 10: Kirton discloses a device for conditioning subjects to take medications comprising a pause button (26) in order to allow a user time to perform the required actions before acknowledging that the event has been completed. Furthermore, it also reduces the chance that the user will simply acknowledge the event without actually performing the instructions. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the pause button, as taught by Kirton, to the device, as taught by Smith, in order to reduce the chance that the user will simply acknowledge the event without actually performing the instructions, as already suggested by Kirton.

With respect to the limitations stated in claim 16: The functional claim language has not been given any patentable weight since the courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure rather than function. See *In re Danley*, 120 USPQ 528,531 (CCPA 1959). See also *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) where the court stated that "apparatus claims cover what a device is, not what a device does." (emphasis in original); *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) where the board stated that a claim containing a "recitation

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with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

Smith discloses a device as stated above with regards to claims 1, 4 and 5. Smith discloses all the subject matter claimed by applicant with the exception of the limitations stated in claim 6, i.e., the produced signal being vibratory.

With respect to the limitation stated in claim 6: Official Notice is taken with respect to claim 6 since it is well known in the timepiece art to use a vibratory signal as an alternative type of signaling means which will proved the same function, if one is replaced with another, of alerting a user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the vibratory signal as claimed by applicant, to the device of Smith, as an alternative type of signaling means.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Green.

Smith discloses a device as stated above with regards to claims 1, 4 and 5. Smith discloses all the subject matter claimed by applicant with the exception of the limitations stated in claim 7, i.e., timer means further including means to produce an alert signal to indicate that a time interval signal will be activated at a near future time.

With respect to the limitation stated in claim 7: Furthermore, Green discloses a timer

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system comprising a microprocessor (64) providing warnings of the approach of the time period in order to advise the user of the approach of the time period. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the warnings command, as taught by Green, to the microprocessor, as taught by Smith, in order to advise the user of the approach of the time period.

9. Claims 13, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith, Tate and Green as applied to claim 11 above, and further in view of US Patent 6,301,196 to Daniel [hereinafter Daniel].

The combination of Smith, Tate and Green disclose a device as stated above with regards to claim 11. The combination of Smith, Tate and Green disclose all the subject matter claimed by applicant with the exception of the limitation stated in claim 13, i.e., a microphone; the limitations stated in claim, 14, i.e., the housing being an elliptical shell, a hanger means and a clip for maintaining the device against independent movement; the limitation stated in claim 15, i.e., vibrator; the limitation stated in claim 17, i.e., a number of normal time intervals is set by comparing the first and subsequent manual operations of the accomplishment switch correlated to a 24 hour period and establishing the new normal time interval ending at the times of peak probability of signal activation.

With respect to the limitation stated in claim 13: Daniel discloses a device for conditioning subjects to take medications comprising a microphone and speaker assembly in order to be able to record various instructions to be played at various time intervals. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was



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made to replace the speaker, as taught by the combination of Smith, Tate, and Green, with the microphone and speaker assembly of Daniel, in order to be able to record various instructions to be played at various time intervals, as already suggested by Daniel.

With respect to the limitation stated in claim 14, the shape of the housing, i.e., elliptical shell, absent any criticality, is only considered to be an obvious modification of the shape of the housing disclosed by the combination of Smith, Tate, Green and Daniel as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

With respect to the limitations stated in claim 14, i.e., a hanger means and a clip: Official Notice is taken with respect to claim 14 since it is well known in the timepiece art to use various types of fastening means in order to fasten a timepiece to a user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the hanger and clip assembly as claimed by applicant, to the device of Smith, Tate, Green and Daniel, as an alternative type of fastening means which will proved the same function, if one is replaced with another, of fastening the device to the user.

With respect to the limitation stated in claim 15: Official Notice is taken with respect to claim 15 since it is well known in the timepiece art to use a vibrator as an alternative type of signaling means which will proved the same function, if one is replaced with another, of alerting a user. Therefore, it would have been obvious to a person having ordinary skill in the art

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at the time the invention was made to add the vibrator as claimed by applicant, to the device of Smith, as an alternative type of signaling means.

With respect to the limitations stated in claim 17: The functional claim language has not been given any patentable weight since the courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure rather than function. See *In re Danley*, 120 USPQ 528,531 (CCPA 1959). See also *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) where the court stated that "apparatus claims cover what a device is, not what a device does." (emphasis in original); *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) where the board stated that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim.

10. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view US Patent 5,365,496 to Tolan-Samilow [hereinafter Tolan-Samilow].

Smith discloses a device as stated above with regards to claims 1, 4 and 5. Smith discloses all the subject matter claimed by applicant with the exception of the limitations stated in claims 18-20, i.e., a reward means; and the limitation stated in claims 21 and 22, i.e., the particular type of reward.

With respect to the limitations stated in claims 18-20: Tolan-Samilow discloses a device comprising a reward circuit (8) in order to provide a stimulus, e.g., "a job well done", following a correct or desired response. Therefore, it would have been obvious to a person having ordinary

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skill in the art at the time the invention was made to add the reward circuit, as taught by Tolan-Samilow, to the device of Smith, in order to provide a stimulus for following a correct or desired response, as already suggested by Tolan-Samilow.

With respect to the limitation stated in claims 21 and 22: The particular type of reward chosen is a mere selection of alternatives lacking any criticality.

***Response to Arguments***

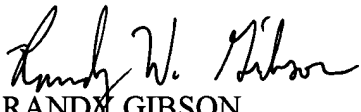
11. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barker discloses a device using a vibration device and having a reminder mode.

13. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Jeanne-Marguerite Goodwin whose telephone number is (703) 305-0264. The examiner can normally be reached on Monday-Friday (9am-6pm), alternate Fridays off. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JMG  
Oct. 21, 2003

  
RANDY GIBSON  
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